

REMARKS

The Office Action of April 1, 2009 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-6 and 13-18 were pending prior to the instant amendment, with claims 7-12 and 19-24 having been canceled previously. By this amendment, claims 1-3 and 13-15 have been amended. Consequently, claims 1-6 and 13-18 are currently pending in the instant application, with claims 1-3 and 13-15 being independent.

In the Office Action, claims 3-6¹ and 15-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. In response, Applicants have amended claims 3 and 15² as shown above. Thus, Applicants respectfully request that the 112 rejection be withdrawn.

Additionally, claims 1-4 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,156,986 to Wei et al. (Wei). Wei, however, fails to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent claims 1-3, as amended, each recite a combination that includes, among other things:

wherein the insulating film is formed to have a laminated-layer structure.

(See, for example, FIGS. 2A-2D and page 3, line 28 to page 4, line 12 of the application). At the very least, Wei fails to disclose or suggest any of these exemplary features recited in the independent claims 1-3.

¹ On page 2 of the Office Action, it is believed that the Examiner stated in error claims 3-16 instead.

² On page 2 of the Office Action, it is believed that the Examiner stated in error claim 14 instead.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Wei patent. *See* M.P.E.P. § 2131(7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. *See In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner’s bare assertion that claims were obviously anticipated by a reference did not inform the Applicants as to why the claims lacked novelty); *Dickinson v. Zurko*, 527, U.S. 150 (1999) (The U.S. Patent Office’s findings of fact must be reviewed by the substantial evidence standard).

Viewed against this backdrop, each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness “less to ‘haze of so-called expertise’ acquire insulation from accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b). In this case, however, the Examiner cannot satisfy his burden of demonstrating how Wei, taken alone or in combination with any other prior art reference, can either render obvious each and every one of the limitations present in independent claims 1-3 as required by the Manual of Patent Examining Procedure (“MPEP”) and Federal Circuit jurisprudence.

The Examiner asserts that Wei discloses “a semiconductor element comprising: a layer comprising titanium (14) formed over a substrate (12); a gate electrode layer (16) formed over the layer comprising titanium; a gate insulating film (28) formed in contact with a top surface of the gate electrode layer and a top surface of the layer comprising titanium; a semiconductor film (30) formed over the gate insulating film; a pair of n-type impurity regions (32) formed over the semiconductor film; an insulating film (48) that is interposed between the pair of n-type impurity regions and that is formed over the semiconductor film; and a conductive layer (34, 36) formed over the pair of n-type impurity regions.”

However as noted above, Applicants have amended independent claims 1-3 to recite the feature of “the insulating film is formed to have a laminated-layer structure.” Support for the amendment can be seen in FIG. 2A-2D, which belongs to the elected Species II, and at page 3, line 28 to page 4, line 12.

On the other hand, it appears that Wei discloses “a passivation layer 48” which may correspond to the insulating film and discloses that “the passivation layer is typically about 2,000Å thick and may be silicon dioxide, silicon nitride or other insulators such as polyimide” in column 8, lines 37-46. However, Applicants contend that Wei fails to disclose the feature of the insulating film is formed to have a laminated-layer structure, as presently claimed. Therefore, it cannot be said that Wei anticipates the present invention, as claimed.

Further, it should be noted that it is disclosed that “the second insulating film serves as not only a channel protective film but also as a mask for removing a first protective film formed all over a substrate by CVD or the like” at page 4, lines 3-5 of the application. Therefore, Applicants contend that the newly-added feature is not on the basis of its suitability for the intended use as a matter of obvious design choice.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Wei cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Additionally, claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wei as applied to claims 1-3 above and further in view of U.S. Patent No. 6,956,236 to Sasaki et al. (Sasaki) and claims 13-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wei in view of Sasaki. Wei, taken in combination with Sasaki, however, fails to render the claimed invention unpatentable as discussed above. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 1-3 and 13-15.

The Examiner has failed to establish a *prima facie* case of obviousness for at least three reasons. First, the Examiner has not demonstrated how Wei and Sasaki, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Wei, the base reference, based on the teachings of Sasaki, the secondary reference, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the apparatus of Wei in a manner that could somehow result in the claimed invention. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Wei, taken alone or in combination with Sasaki, can either anticipate or render obvious each and every one of the limitations present in independent claims 1-3 and/or 13-15, as required by the M.P.E.P. and Federal Circuit jurisprudence.

The Examiner attempts to remedy the deficiencies of Wei by turning to Sasaki. Sasaki discusses a layer comprising titanium oxide (40b at Fig. 1). However, Sasaki fails to disclose or suggest the feature of the insulating film being formed to have a laminated-layer structure, as recited in claims 1-3 and 13-15.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully

submitted that neither Wei nor Sasaki, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1-3 and 13-15. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1-3 or 13-15 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1-3 and 13-15.

In addition, each of the dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not anticipated or rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicants in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at (202) 585-8100.

Respectfully submitted,

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